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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,298	10/10/2003	Chin-Kuang Luo	SIS.0162US (PE-24472-AM)	3087
21906	7590	09/08/2004	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			BRINSON, PATRICK F	
		ART UNIT	PAPER NUMBER	
		3752		

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/684,298	LUO ET AL.
	Examiner Patrick F. Brinson	Art Unit 3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) 3-9 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \*    c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the filling hole has a closed end adjacent to the inner side, however, in claim 1 the filling hole is recited as being in fluid communication with the receiving space. It is not made clear how the filling hole is closed and is in fluid communication with the receiving space.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by 3,424,329 to

**Hershberg et al.**

The patent to **Hershberg et al.** discloses a sealed injection vial comprising a hollow body (12) having a receiving space and an opened end. A cover member (28, 38) covering the open end, with the cover member having an inner side facing the receiving space and an outer side opposite to the inner side, a filling hole (34, 46) formed in the cover member, in fluid communication with the receiving space and extending through the outer side. An elastic sealing member (26), including a pair of discs (22, 24) fitted within the filling hole and a fluid disposed within the receiving space, wherein the elastic sealing member is pierceable to provide passage for injection of a fluid through the elastic sealing member and is contractible to seal the passage, as recited in claim 1. **Hershberg et al.** does not disclose the hollow body as receiving a heat transfer fluid, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US 3,092,278 to **Jarnhall**.

The patent to **Jarnhall** discloses a cap for a container of injection liquid including a hollow body (4) having a receiving space and an opened end. A cover member (2) covering the open end, with the cover member having an

inner side facing the receiving space and an outer side opposite to the inner side, a filling hole (7) formed in the cover member, extending through the outer side. An elastic sealing member (8) fitted within the filling hole and a fluid disposed within the receiving space, wherein the elastic sealing member is pierceable to provide passage for injection of a fluid through the elastic sealing member and is contractible to seal the passage, as recited in claim 1. **Jarnhall** does not disclose the hollow body as receiving a heat transfer fluid, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

4. Claims 1 and 2 rejected under 35 U.S.C. 102(b) as being anticipated by 5,514,339 to **Leopardi et al.**

The patent to Leopardi et al discloses a hollow body (3) having a receiving space and an opened end. A cover member, fig. 2, (1) covering the open end, with the cover member having an inner side facing the receiving space and an outer side opposite to the inner side, a filling hole (14) formed in the cover member, in fluid communication with the receiving space and extending through the outer side. An elastic sealing member (2A) fitted within the filling hole and a fluid disposed within the receiving space, wherein the elastic sealing

member is pierceable to provide passage for injection of a fluid through the elastic sealing member and is contractible to seal the passage, as recited in claim

1. The filling hole has a closed end adjacent the inner side, but further includes a seat part at the inner side, wherein the seat part includes slits (13) that function as needle holes, as shown in figs. 4 and 7, which extend through the inner side and communicate with the filling hole, as recited in claim 2.

**Leopardi et al.** does not disclose the hollow body as receiving a heat transfer fluid, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

#### *Allowable Subject Matter*

5. Claims 3-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Anderson et al. '847 and '044, Percarpi, Thibault et al., Carano, Flynn, Konrad, and Novitch are pertinent to Applicant's invention in disclosing sealing caps on receptacles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (703) 308-0111. The examiner can normally be reached on M-F 7:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Y. Mar** can be reached on (703) 308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick F. Brinson  
Primary Examiner  
Art Unit 3752

P. F. Brinson  
September 7, 2004